

Agilent Ref: 10004190-1  
United States Application Serial No. 09/846,058

## REMARKS

### Formal Matters

Claims 1-9 and 27-46 are pending.

Claims 1, 4, 27, 28, 29, 35 and 37 are amended and claims 39-46 are added herein.

Support for the amendment and the new claims is found in the claims as originally filed, and throughout the specification, in particular at the following exemplary locations: original claim 1; original claim 4; page 2, lines 1-2; page 7, lines 3-9; and page 8 lines 7-9. Claim 29 has been amended to be in independent form.

No new matter is added.

Applicants respectfully request reconsideration of the application.

### Allowable subject matter

The Examiner's indication that claims 29 and 31 contain allowable subject matter is gratefully acknowledged.

Claim 29 is amended to be in independent form.

New claims 39-44 are dependent on claim 29 and claim 35 has been amended to be dependent on claim 29. As such, the Applicant respectfully submits that 29, 31, 35 and 39-44 each recite allowable subject matter and may be allowed.

Allowance of claims 29, 31 35 and 39-44 is respectfully requested.

### Rejection of claims under 35 U.S.C. § 112, second paragraph

Claim 1 is rejected for reciting the phrase the term "the chemical moieties", for which there is assertedly no antecedent support.

Without wishing to acquiesce to the correctness of this rejection, claim 1 has been amended to recite "the *different* chemical moieties", in accordance to the Examiner's suggestion.

The Applicant respectfully submits that this rejection has been adequately addressed and may be withdrawn.

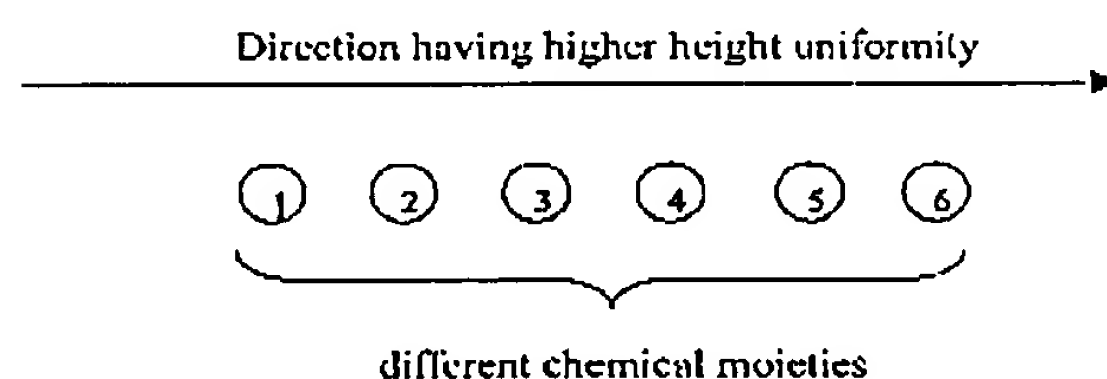
Agilent Ref: 10004190-1  
United States Application Serial No. 09/846,058

**Rejection of claims under 35 U.S.C. § 102(e)**

Claims 1-9, 27, 30 and 32-36 are rejected under 35 U.S.C. § 102(e) as being anticipated by Indermuhle (US20010036674). The Applicants respectfully traverse this rejection.

The Applicants respectfully submit that Indermuhle fails to disclose, either explicitly or inherently, any method in which *different chemical moieties are placed along rows that are more closely aligned with a direction having the higher height uniformity*. The Applicants further submit that Indermuhle further fails to disclose, either explicitly or inherently, any step in which height uniformity across two different directions across a substrate are *compared to identify a direction having a higher height uniformity*. Accordingly, Indermuhle fails to disclose at least one element of each the rejected claims and this rejection may be withdrawn.

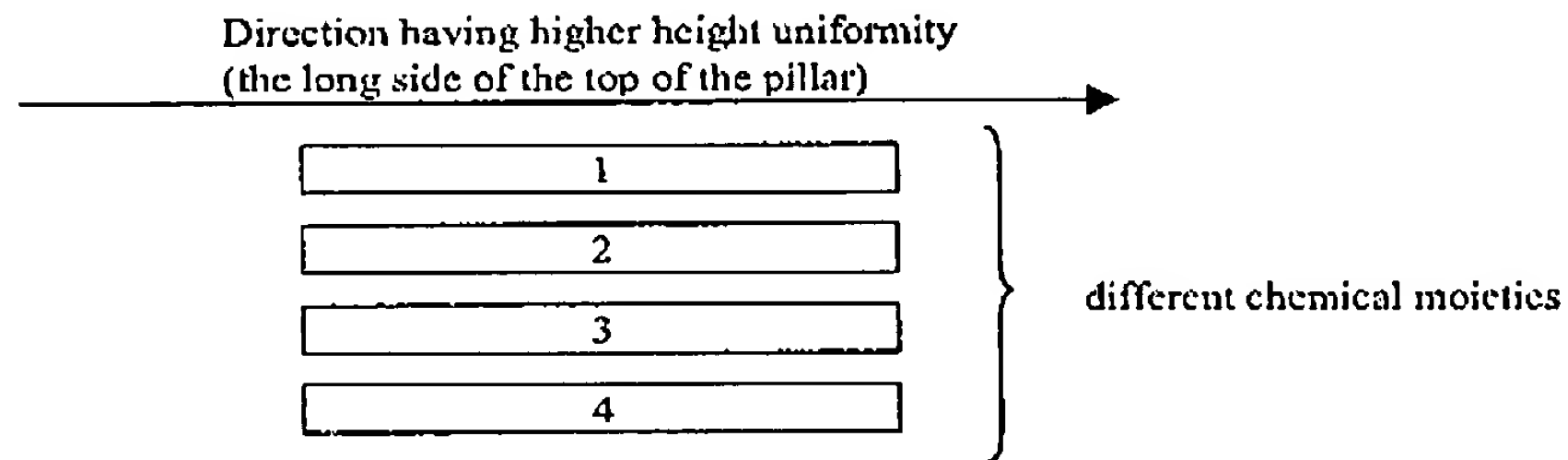
Claims 1, 4, 17 recite placing different chemical moieties on a substrate so as to provide features thereon along rows more closely aligned with a first direction than a second direction. Since the first direction is the direction with higher height uniformity, claims 1, 4, 17 require that *different chemical moieties* are placed *in rows* in the direction having higher height uniformity. In an exemplary embodiment, the different chemical moieties may be placed in rows parallel to the direction having higher height uniformity. The following figure illustrates this embodiment:



The Applicants respectfully submit that Indermuhle does not disclose this element. In support of this rejection, the Office points towards Indermuhle's Fig. 24 and argues that elements 133 places chemicals on the tops of rectangular pillars 132 to provide a substrate containing different chemical moieties placed in a row in a direction having higher height

Agilent Ref: 10004190-1  
 United States Application Serial No. 09/846,058

uniformity. As illustrated by the following figure, however, Indermuhle's different chemical moieties are not placed in a row *along* a direction having higher height uniformity.



As a point of fact, Indermuhle's different chemical moieties are actually placed in a row *perpendicular* to the direction having higher height uniformity.

Accordingly, Indermuhle fails to disclose any method in which *different chemical moieties* are placed *in a row* in a direction having higher height uniformity. This element is simply not disclosed by Indermuhle and, as such, Indermuhle cannot anticipate the rejected claims.

New claims 45 and 46 recite "placing the different chemical moieties *in a line on the substrate so as to provide a row of distinct features that is more closely aligned with the first direction* than the second direction". Since Indermuhle merely discloses placing different chemical moieties in a row that is *perpendicular* to the direction having higher height uniformity, the Applicants respectfully submit that claims 45 and 46, like claims 1-9, 27, 30 and 32-36, recite elements that are not disclosed by Indermuhle.

Further, claims 1, 27 and 28 recite a "comparing" step in which height uniformity of a first direction and height uniformity of a second direction are compared to identify a direction having higher height uniformity.

Again, the Office asserts that such a step is disclosed by Indermuhle's Fig. 24. The Office argues that because Indermuhle does not intend to place any samples anywhere other than the tops of the elongated pillars 132, the *x* and *y* directions of Indermuhle's substrate must have been compared.

Agilent Ref: 10004190-1  
United States Application Serial No. 09/846,058

As discussed in the MPEP at § 2112: "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic."<sup>1</sup> (emphasis in the original). Accordingly, in order for such a rejection to be correctly established, according to the MPEP, a claim limitation that is not explicitly taught must be inherent, i.e., necessarily present, in the cited prior art. The mere possibility that the limitation is taught in the art is not sufficient to merit such a rejection, and the mere fact that a certain thing *may* result from a given set of circumstances is also not sufficient.<sup>2</sup>

In contrast to the Office's position, however, the Applicants respectfully submit that there are a multitude of different ways (other than by comparing height uniformities) that Indermuhle's samples may be accurately placed on the tops of the elongated pillars. For example, Indermuhle's samples may be accurately placed on the tops of the elongated pillars 132 using alignment members (e.g., alignment marks or an alignment structure such a pin or a hole, for example; see paragraph 105 on page 9 of Indermuhle). These exemplary methods may be performed in the absence of any comparison of substrate height uniformities. In other words, the step of comparing height uniformities is not *inherent* in the method represented by Indermuhle's Figure 24, and, as such, Indermuhle does not disclose the subject matter of the rejected claims.

In view of the above discussion, the Applicants respectfully submit that Indermuhle fails to teach at least one element of each of the rejected claims. Withdrawal of this rejection is respectfully requested.

#### Claim objections

Claim 35 is objected to as being a substantial duplicate of claim 33.

Without wishing to acquiesce to the correctness of this rejection, the dependency of claim 35 has been amended. Claim 35 is now dependent on claim 29.

The Applicant respectfully submits that this rejection has been adequately addressed and may be withdrawn.

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<sup>1</sup> MPEP at § 2112, citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)

<sup>2</sup> MPEP at § 2112 "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' "*In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

Agilent Ref: 10004190-1  
United States Application Serial No. 09/846,058

Claim 36 is objected to for reciting the phrase "is communicated is", which is assertedly grammatically incorrect.

Without wishing to acquiesce to the correctness of this rejection, claim 36 has been amended to recite the phrase "is communicated via".

The Applicant respectfully submits that this rejection has been adequately addressed and may be withdrawn.

**Rejection of claims under 35 U.S.C. § 103(a)**

Claims 1-9, 27-28, 30 and 32-38 are rejected under 35 U.S.C. § 103(a) as unpatentable over Indermuhle in view of Cattell (US20020102559).

The Applicants submit that the subject matter of the cited Cattell patent application and the claimed invention were, at the time the invention was made, assigned or under obligation of assignment to Agilent. Accordingly, Cattell cannot preclude the patentability of the rejected claims, and this rejection may be withdrawn.

Support for this assertion is set forth below:

35 U.S.C. 103 (a) states that a patent may not be obtained if the differences between the claimed subject matter and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made<sup>3</sup>. 35 U.S.C. 103 (c), however, states that subject matter developed by another person shall not preclude patentability under 103(a) where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.<sup>4</sup>

According to 35 USC § 103(c), therefore, the Cattell patent application cannot preclude the patentability of the rejected claims if the Cattell patent application and the instant application were assigned to the same person or subject to an obligation of assignment to the same person, at the time the instant invention was made.

<sup>3</sup> 35 U.S.C. 103(a) : A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

<sup>4</sup> 35 U.S.C. 103(c): Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Agilent Ref: 10004190-1  
United States Application Serial No. 09/846,058

The invention claimed in the instant patent application was owned by Agilent Technologies, Inc. ("Agilent") or subject to an obligation of assignment to Agilent at the time the instant invention was made, as evidenced by an assignment executed by the inventors (Recd/Frame 013365/0320). This assignment was recorded on January 16, 2003.

The Cattell patent was owned by Agilent or subject to an obligation of assignment to Agilent at the time the instant invention was made, as evidenced by an assignment executed by the inventors (Recd/Frame 013365/0213). This assignment was recorded on January 16, 2003.

Thus, the Cattell patent and the claimed invention were, at the time the invention was made, assigned or under obligation of assignment to Agilent. Accordingly, Cattell cannot preclude patentability of the instant claims under 103(a).

In view of the disqualification of Cattell as a prior art reference, this rejection of claims 1-9, 27-28, 30 and 32-38 under 35 U.S.C. § 103(a) may be withdrawn.

Agilent Ref: 10004190-1  
United States Application Serial No. 09/846,058

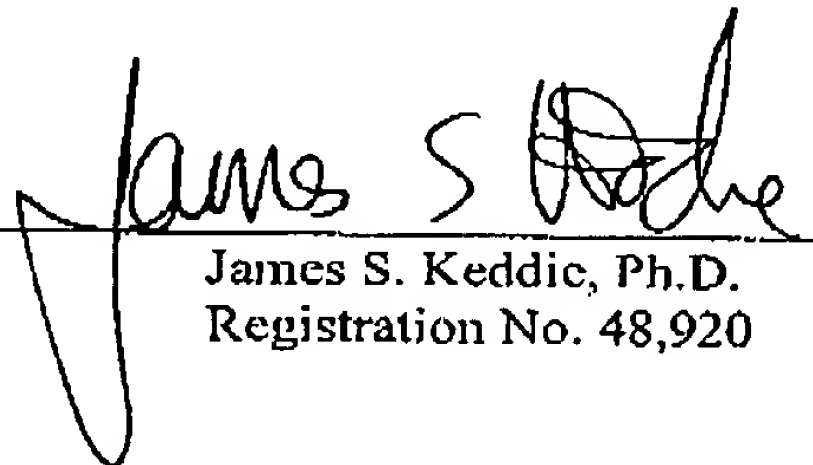
### CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

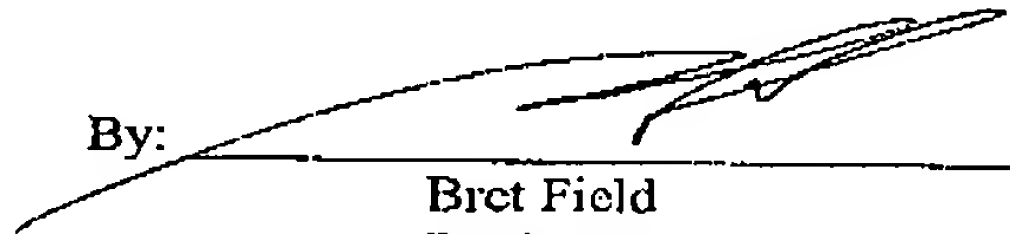
The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,  
BOZICEVIC, FIELD & FRANCIS LLP

Date: Sept 8, 2004

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